

REMARKS

Applicant responds in like numbered paragraphs to Examiner's Office Action mailed March 14, 2003.

1. The election has been affirmed.
2. The Hibbard reference teaches the state of the prior art for basic Whirlpool design; showing a tub with sides, a bottom and recirculating water system. The Patil reference teaches using an antimicrobial filter cartridge, wherein Patil's claim 1 has been added herein as dependant claim 66.
3. The figures 3,6 issue of items 30,31 has been addressed with creating an arrow for item 31 which is the whole housing, and using a line for item 30 which is a flange.

Regarding the folding membrane 43, figures 12 and 13 are correct. However, figure 10 has been corrected.

Regarding the missing "h" figure 19 has been corrected to indicate what the specification clearly described without adding new matter. Also Applicant corrected a duplicate use of item 1804, wherein the tube is now labeled 1894. Also the open end is now labeled 1808 rather than 1805.

Regarding the cross hatching of figures 22,23, the edges of the sliced portions are now cross hatched.

4. The housing means includes figure 3 item 31, and the faceplate means includes figure 3 item 20. Other embodiments include housing 50 of figure 5, housing 310 of figure 14, housing

1501 and faceplate 1502 of figure 15, housing 2420 and faceplate 2402 of figure 24, and housing (base) 14P and faceplate (cover) 12PP of figures 27-29.

The "pop off connection" and "pop off design means" of the removable filter include housing outlet 39 of figure 3, outlet port 1503 of figure 15 with mounting collar 1805, and item 60P of figure 29. The "pop off design means" of the faceplate means includes faceplate 2402 and housing 2420 of figure 25.

The "safety/sanitation port means" of claim 50 is included in figure 18 old item 1803 (specification page 21, line 31), now properly renumbered as 2003.

5. Applicant has reprinted all claims and believes hierarchy is proper.

6. Citation of §102, 103.

7. Claim 19 is canceled due to the §101 double patenting rejection. Applicant argues that Zars is not a §102(e) reference because the figures of the present application which form the basis of the means + function claim 19 differ from Zars' disclosure.

Claim 47 has been canceled due to the §101 double patenting rejection. Claims 48 and 49 have been canceled, but will be reintroduced with new argument in a later application. Applicant does not agree with Examiner's rejection of claims 48,49 but desires a timely issue of the present application. Applicant will argue claims 48,49 in a future application.

Original claim 50 is amended to include those limitations of original claim 47, thereby complying with Examiner's paragraph 15 to make amended claim 50 allowable, since it has the limitations of original claims 47,50.

8. Watkins discloses a skimmer/filter that does not drain after each use, (it also sits above the water line) because his device is made for spas and pools which stay filled between uses.

Claims 1, 19, and 47 have been canceled due to the §101 double patenting rejection. New claims 64 and 67-69 have been added with the drainage aspect featured.

Regarding claims 22, 33-35 and 49, Applicant disagrees with the 102/103 issues raised by Examiner, but has withdrawn these claims in an effort to get a timely issue date for this application. Applicant will file a future continuation application or continuation-in-part application and argue these issues at that time.

9. Claims 19 and 47 have been withdrawn due to the §101 double patenting rejection. Claims 48 and 49 have been canceled with traverse and argument reserved for a later application.

10. Claim 1 has been withdrawn due to the §101 double patenting rejection. Claims 21, 22 and 33-35 have been canceled with traverse and additional argument reserved for a later application. Neither Zars nor Watkins suggest a drainage limitation because their inventions are designed for use in continuously full pools or spas. A §103 rejection is improper.

11. Citation of §101.

12. Claims 1, 19, and 47 are canceled due to the §101 double patenting rejection.

13. A Terminal Disclaimer is attached.

14. Baker et al. is a skim filter similar to Watkins, and neither reference suggests draining after each use as noted above.

15. Claims 23, 24, 26, 30, 36, 37, and 50 have been rewritten in independent form to include all of the limitations of the base claim and any intervening claims, and should be allowable. Claim 25 depends from now independent claim 24, and claims 27-29 depend either directly or indirectly from now independent claim 26.

16. Applicant believes this Amendment is fully responsive and puts all claims in conformance with the specification for support.

17. Applicant's attorney, Rick Martin, is available for any discussions at 303-651-2177, Mountain Daylight Time M-F, 9-5.

LAW OF OBVIOUSNESS

It is well known that most inventions are composed of elements that *per se* are old and well known. That however, does not make an invention "obvious" under 35 U.S.C. 103. The Examiner's attention is respectfully drawn to, for example, *ACS Hospital Systems, Inc. v. Montefiore Hospital et al.*, 221 USPQ 929, wherein the CCPA held that "Obviousness cannot be established by combining teachings of prior art to produce claimed combination, absent some teaching or suggestion supporting combination; teachings of references can be combined only if there is some suggestion or incentive to do so, under 35 U.S.C. 103."

Also, as stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F2d 1540, 220 USPQ 303 (Fed. Cir. 1983):

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Finally, even if the constituents of an invention may be old, if the result would not have been obvious at the time of invention, then the result may be patentable. *Reiner v. I. Leon Co.*, 285 F2d 501, 128 USPQ 25, (1960 CA2 NY).

In order to determine the basis for the rejection, the Examiner must:

- 1). Determine the scope and contents of the prior art;
- 2). Ascertain the differences between the prior art and the claims in issue;
- 3). Resolve the level of ordinary skill in the pertinent art; and
- 4). Evaluate evidence of secondary considerations.

Other basic considerations include:

- 1). The claimed invention must be considered as a whole;
- 2). The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- 3). The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- 4). Reasonable expectation of success is the standard with which obviousness is determined.

Finally, to sustain a *prima facie* case of obviousness:

- 1). There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2). There must be a reasonable expectation of success; and
- 3). The prior art reference must teach or suggest all the claim limitations.

The Examiner fails to meet the requirements to sustain an obviousness rejection based on these references.

LAW OF ANTICIPATION

Section 102 (e) provides:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent....

A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described, in a single prior art reference. See: *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed Cir. 1987), *Structural Rubber Prods. CO. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270, (Fed. Cir. 1984), *Connell*, 722 F.2d at 1548, 220 USPQ at 198; *Kalman v. Kimerly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026, 104 S. Ct. 1284, 79 L. Ed.2d 687 (1984).

Applicant respectfully requests the Examiner to pass this application to allowance.

Respectfully submitted,



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